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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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Gene E. Nacey

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03/16/2010

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3686

MAIL DATE

DELIVERY MODE

03/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/808,423 | NACEY, GENE E. | |
| | Examiner | Art Unit | |
| | Natalie A. Pass | 3686 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 2 December 2009. Claims 39-42, 44, 50, 56, 62 have been amended. Claims 1-38, 76 have been canceled. Claims 39-75 remain pending.

Claim Objections

2. The objection to claim 76 for informalities is hereby withdrawn due to the amendment filed 2 December 2009.

Claim Rejections - 35 USC § 101

3. The rejection of claims 39-61 under 35 U.S.C. §101 is hereby withdrawn due to the amendment filed 2 December 2009.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 39-75 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention for substantially the same reasons given in the previous Office Action (paper number 20090822). Further reasons appear hereinbelow..

(A) Newly amended claim 39 continues to recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- “establishing and storing preselected nutritional criteria in said memory,” as disclosed at line 10.

(B) Newly amended claim 62 continues to recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- “establishing preselected nutritional criteria,” as disclosed at line 15.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 14 March 2001. Applicant is respectfully

requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(C) Claims 40-61, 63-75 incorporate the features of independent claims 39 and 62, through dependency, and are also rejected.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 14 March 2001.

7. The rejection of claim 76 under 35 U.S.C. §112, first paragraph is hereby withdrawn due to the amendment filed 2 December 2009.

8. The rejection of claims 62-75 under 35 U.S.C. §112, second paragraph is hereby withdrawn due to the amendment filed 2 December 2009.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in the 2 June 2009 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 5-7 above in the next communication sent in response to the present Office Action.

10. Claims 39-41, 44-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al., U.S. Patent Number 6, 370, 513 in view of Cosentino et al., U.S. Patent Number 6, 290, 646 and further in view of Petot, et al. article: "An artificial intelligence system for computer-assisted menu planning," Sept. 1998, hereinafter known as Petot for substantially the same reasons given in the previous Office Action (paper number 20090822). Further reasons appear hereinbelow.

(A) Claim 39 has been amended to recite a method that includes databases stored in a computer based system that uses a processor to evaluate nutritional contents of each food item and that tracks an inventory of food items in memory and that provides a remote electronic data link to food service professionals and that provides nutritional information associated with menu sets electronically to food service professionals and stores preselected nutritional criteria in memory. As per these amendments, Kolawa clearly teaches databases stored in a computer based system (Kolawa; Figure 2, column 1, lines 16-22, column 5, lines 45-52) that uses a processor to "analyze" (reads on "evaluate") "the chemical components in the specified foods" (reads on "nutritional contents of each food item") (Kolawa; Figures 26A to 26D, column 7, lines 15-17,

column 9, lines 15-21, column 16, lines 29 to column 17, line 33, column 3, lines 25-31) (Examiner interprets Kolawa's teachings of analysis of food products into "attributes" that include "protein," "total lipid (fat)," "carbohydrate (by difference)," "energy" (i.e. calories), "water" (i.e. moisture), "sugars, total," "fiber, total dietary," "calcium," iron," "magnesium," "phosphorus," "potassium," "sodium," and "zinc" (Kolawa; Figure 26A) to be a form of "evaluating nutritional contents of each food item") and that tracks an inventory of food items in computer memory (Kolawa; Figure 11, column 13, lines 29-39) and that stores preselected nutritional criteria in memory (Examiner interprets Kolawa's teachings of a user database that keeps track of the needs of the user (Kolawa; Abstract, column 10, lines 41-43) and that stores "non-waivable preferences" relating to food to allow the system to compare the product vectors in the recommendation database to the user preference vector in the user preference database (Kolawa; column 6, lines 29-44) to teach a form of storing preselected nutritional criteria in memory). Cosentino teaches providing a remote electronic data link to "nutritionists" (reads on "food service professionals") and providing nutritional information associated with menu sets electronically to "nutritionists" (reads on "food service professionals") (Cosentino; column 2, lines 25-62).

As per the remaining amendments to claim 39, these appear to have been made merely to correct minor typographical or grammatical errors in the claim language or to correct rejections under 35 USC § 101. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as

originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20090822, section 13, pages 9-14), and incorporated herein.

The motivations for combining the respective teachings of Kolawa, Cosentino and Petot are as given in the rejection of claim 39 in the previous Office Action (paper number 20090822), and incorporated herein.

(B) As per the amendments to claims 40-41, 44, 50, 56, 62, these appear to have been made merely to correct minor typographical or grammatical errors in the claim language or to correct rejections under 35 USC § 101. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20090822, section 13, pages 14-19), and incorporated herein.

(C) Claims 45-49, 51-55, 57-61, 63-75 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20090822, section 13, pages 14-19), and incorporated herein.

11. Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al., U.S. Patent Number 6, 370, 513 in view of Cosentino et al., U.S. Patent Number 6, 290, 646 and Petot, et al. article: "An artificial intelligence system for computer-assisted menu planning," Sept. 1998, hereinafter known as Petot, as applied to claim 39 above, and further in view of Brown, U.S. Patent Number 6, 168, 563, for substantially the same reasons given in the previous Office Action (paper number 20090822). Further reasons appear hereinbelow.

(A) As per the amendments to claim 42, these appear to have been made merely to correct minor typographical or grammatical errors in the claim language or to correct rejections under 35 USC § 101. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20090822, section 14, pages 19-20), and incorporated herein.

(B) Claim 43 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 20090822, section 14, pages 19-20), and incorporated herein.

Response to Arguments

12. Applicant's arguments filed 2 December 2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 2 December 2009.

(A) At pages 11-15 of the response filed 2 December 2009, Applicant argues that the limitations of claims 39-75 are not taught or suggested by the applied references. In response, all of the limitations, including the newly added limitations, which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as being obvious in view of the combined teachings of Kolawa, Cosentino, Petot and Brown, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the previous Office action (paper number 20090822).

As per Applicant's argument in the paragraph bridging pages 12-13 of the 2 December 2009 response that the Kolawa reference fails to teach "a system which evaluates nutritional data and establishes preselected nutritional criteria based upon this data," Examiner respectfully notes that this is not a claimed limitation.

As per Applicant's argument in the paragraph bridging pages 12-13 of the 2 December 2009 response that the Kolawa reference fails to teach a system which evaluates the inputted data based upon preselected criteria, Examiner respectfully submits that it was the Petot reference, not Kolawa, which was applied to teach this limitation (Petot; Figure 1, page 1010, paragraph

bridging columns 1- 2, page 1011, column 1, paragraphs 2-3, page 1014, column 1, paragraph 2 to column 2, paragraph 1). Examiner interprets Petot's teachings of " ... [...] ... Add Nutrition Criteria ... [...] ... Output Recommended Menu ... [...] ... " (Petot; Figure 1) and " ... [...] ... adjust their diet to reduce energy intake or control specific nutrient content ... [...] ... systems meet numeric constraints, including nutrient minimums and maximums ... [...] ..." (Petot; page 1010, paragraph bridging columns 1- 2) to teach a form of "establishing preselected nutritional criteria;" and Examiner interprets Petot's teachings of "[n]utrition criteria are added ... [...] ..." and "[t]he retrieved case is adapted to meet any unmet constraints ... [...] ... Nutrient-specific deficiencies are corrected using adaptation rules" to teach a form of evaluating the inputted data based upon preselected criteria (Petot; page 1011, column 1, paragraphs 2-3).

As per Applicant's argument in paragraph 1 on page 13 of the 2 December 2009 response that the Kolawa reference fails to teach verified nutritional values with respect to menu selection, Examiner respectfully disagrees, and submits that Kolawa teaches verifying a "chemical component" (reads on "a nutritional value") of each of said plurality of recipes in said recipe database (Kolawa; Figure 15, Figure 17, column 3, lines 25-31, column 16, lines 52-65, column 17, lines 10-33) and assigning various food attributes to said recipes based upon said verified nutritional values (Kolawa; Figures 26A TO 26D, column 3, lines 27-31, column 16, lines 29-32). Moreover, although Kolawa's language is not identical to Applicant's language, Examiner notes that courts have determined that " ... [...] ... a reference ... [...] ... is prior art for all that it teaches" (see *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989)). In addition, Examiner submits that the Brown reference

also teaches that verification of nutritional value of each of said plurality of recipes is based upon said evaluation of nutritional content and said evaluation of diabetic exchange rates of each food item (Brown; column 21, lines 32-53, column 22, lines 44-55).

At pages 14-16 of the 2 December 2009 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

As per Applicant's arguments on pages 13-14 of the 2 December 2009 response that the Cosentino reference fails to teach "a *system* which establishes preselected nutritional criteria and suggests menu sets in accordance with the preselected nutritional criteria to a food service professional," Examiner respectfully disagrees. Examiner submits that Cosentino teaches a method including making nutritional information available to said "nutritionists" (reads on "food service professionals") (Cosentino; column 2, lines 25-62) and "adapt[ing] the individual's diet"

(reads on “suggesting menu sets”) to said food service professionals (Cosentino; column 2, lines 25-34, 41-46, 56-62). In addition, Examiner interprets Petot’s teachings of “ ... [...] ... Add Nutrition Criteria ... [...] ... Output Recommended Menu ... [...] ... ” (Petot; Figure 1) and “ ... [...] ... adjust their diet to reduce energy intake or control specific nutrient content ... [...] ... systems meet numeric constraints, including nutrient minimums and maximums ... [...] ... ” (Petot; page 1010, paragraph bridging columns 1- 2) to teach a form of “establishing preselected nutritional criteria;” and Examiner interprets Petot’s teachings of “[n]utrition criteria are added ... [...] ... ” and “[t]he retrieved case is adapted to meet any unmet constraints ... [...] ... Nutrient-specific deficiencies are corrected using adaptation rules” to teach a form of “suggesting menu sets in accordance with said preselected nutritional criteria to said food service professionals” (Petot; page 1011, column 1, paragraphs 2-3).

As per Applicant’s remaining arguments in pages 14-15 of the response filed on 2 December 2009, that none of the applied reference teach limitations recited in claims 39 and 42, these arguments have been discussed earlier in this Office Action.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to Applicant’s disclosure.

14. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any response to this final action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark "EXPEDITED PROCEDURE".

16. For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on 9-6:30 Monday - Thursday and alternate Fridays.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
March 12, 2010

/Gerald J. O'Connor/
Supervisory Patent Examiner
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